

8



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,479	10/19/2001	Rodney Gordon Webster	16869S-036900US	3559
20350	7590	09/15/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			PHAM, CHRYSTINE	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8

# Office Action Summary

Application No.

10/057,479

Applicant(s)

WEBSTER ET AL.

Examiner

Chrystine Pham

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/19/01 & 3/25/02
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on June 06, 2001. It is noted, however, that applicant has not filed a certified copy of the 2001-170417 application as required by 35 U.S.C. 119(b).

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*
3. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, the term "optimum" in claim 1 line 12 is a relative term which renders the claim indefinite. The term "optimum" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The office's rationale for viewing the term "optimum" as relative term is such that, depending on different systems and standards of software optimizing/updating, it is possible to define "optimum" update data as being 50%, 75%, or 98% optimized code. Furthermore, a 98% optimized code (e.g., which is defined as optimum update data in one system) might not be in compliance with other systems of higher standards (e.g., optimum update data is defined as 99% optimized) and/or precision (e.g., optimum update data is defined as 99.999% optimized).

Claims 2, 12-13, 20, and 25 recite limitation "optimum update data" (e.g., see claim 2 line 17, claim 12 line 11) which has been addressed in claim 1 above, therefore, are rejected for the same reasons as cited in claim 1.

Claims 3-11, 14-19, and 21-24 are also rejected under U.S.C 112, second paragraph, as claims depending on rejected base claims 2, 12-13, and 20.

4. For compact prosecution of the claims, the office has interpreted the term "optimum" [update data] to refer to data/code/software which have been modified, thus improved and updated.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

5. Claims 1-4, 6, 8-15, 17-20, 22, and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Ryzin (US 5909689), hereinafter, *Van Ryzin*.

As per claim 1, *Van Ryzin* teaches a software updating method for a network apparatus (e.g., see *comp.18, comp.12* FIG.1 & associated text) in a network system (e.g., see FIG.1 & associated text, col.5:65-col.6:2) connecting a plurality of network apparatuses, comprising:

- o a step of **each** (emphasis added) one network apparatus (e.g., see *comp.18, comp.12* FIG.1 & associated text, col.6:5-9) connected to a network (e.g., see FIG.1 & associated text) acquiring system information which contains system component information constituted of system identification information (e.g., see *Computer 10, Computer 12*

Art Unit: 2122

- col.4:5-20) and generation information (e.g., see *Rotateltem*, *Moveltem*, *Deleteltem*, *Zoomltem* col.4:10-14) of software installed in each of the other network apparatuses (e.g., col.2:21-24, col.3:38-40, col.4:5-20, see 202 FIG.2A & associated text);
- a step of acquiring generation information of system update modules from the system update modules (e.g., see *Directory name* col.4:5-20), the system update modules being possessed by the other network apparatuses (e.g., see *Computer 10, 12* col.4:5-20) and used for updating software of the other network apparatuses;
  - a step of obtaining optimum update data (e.g., see *most current version of data files* col.1:63-65, see 240 FIG.2D & associated text, col.4:5-20) necessary for optimizing software of each network apparatus connected to the network, by using generation information contained in the system information and the generation information of the system update modules (e.g., col.3:64-col.4:20); and
  - a step of acquiring system update modules containing the optimum update data from the network apparatuses having the optimum update data (e.g., col.3:64-col.4:20), and transmitting system update modules to **each** (emphasis added) network apparatus necessary for optimizing the software to update the software by using the optimum update data (i.e., latest generation software) (e.g., col.5:8-13 & 46-51,).

As per claims 2-4, they recite limitations which have been addressed in claim 1, therefore, are rejected for the same reasons as cited in claim 1.

As per claim 6, *Van Ryzin* teaches a software updating method as applied to claim 2, wherein the system update module also contains information for acquiring latest system update modules from an external network and the system update module is acquired also from the external network (e.g., see *Internet* col.2:67-col.3:2).

Art Unit: 2122

As per claim 8, *Van Ryzin* teaches a software updating method as applied to claim 1, wherein when a new network apparatus is connected to the network, an update process for the software is executed (e.g., col.1:63-64, col.5:46-51).

As per claim 9, it recites limitations which have been addressed in claims 2 and 8, therefore, is rejected for the same reasons as cited in claims 2 and 8.

As per claim 10, *Van Ryzin* teaches software updating method as applied to claim 2, wherein the system information possessed by each network apparatus contains the last update date and time when the software was updated lastly (e.g., col.2:61-64, see 10:02 am, 08/25/97 col.4:10-11, ); and if the network has two or more network apparatuses capable of executing an update process for the software, the network apparatus having the latest last update date and time becomes a manager to execute the update process (e.g., col.2:12-21 & 64-67, col.5:8-13).

As per claim 11, *Van Ryzin* teaches a software updating method according to claim 1, wherein the system update module also contains an explanation statement of update contents (e.g., col.3:59-62, col.4:52-56); and the explanation statement is presented to a user (e.g., col.5:17-29) to allow the user to determine whether update is performed by using the system update module (e.g., col.4:57-59, FIG.2B, 2C & associated text, col.5:30-37).

As per claims 12-15, and 17, they recite limitations which have been addressed in claim 1, therefore, are rejected for the same reasons as cited in claim 1.

As per claim 18, *Van Ryzin* teaches a network apparatus according to claim 12, wherein the system update module is acquired also from a removable storage medium (e.g., see *tape* col.6:36-37).



As per claims 19-20, 22, and 24-25, they recite limitations which have been addressed in claim 6, therefore, are rejected for the same reasons as cited in claim 6.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

7. Claims 5, 7, 16, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Van Ryzin* further in view of *Sanders* (US 6536017), hereinafter *Sanders*.

As per claim 5, *Van Ryzin* teaches the software updating method as applied to claim 2, wherein the software to be updated includes a plurality of components (e.g., col.1:14-18), the update data updates only some components of the software (e.g., col.4:57-62). *Van Ryzin* does not expressly disclose the apparatus function information made of function identification information describing hardware and software functions of each network apparatus and the system update module also contains compatibility information between hardware and other software and the software is optimized by updating the software by further referring to the apparatus function information and compatibility information. However *Sanders* discloses a software updating method (e.g., see Abstract) for a network apparatus (e.g., see *Logic Device B* FIG.2 & associated text) connected to in a network system (e.g., see Abstract, FIG.1,2 & associated text) to acquire a system update module (e.g., see *Circuit Design 105* FIG.2 & associated text) possessed by another network apparatus (e.g., see *Logic Device A* FIG.2 & associated text, see 300 FIG.3 & associated text) which contains an apparatus function information made of function identification information describing hardware and software functions of each network apparatus (e.g., see *Report File 110*, *Circuit Design 105* FIG.1 &

associated text, see FIG.4,6 & associated text) and the system update module also contains compatibility information between hardware and other software (i.e., update data and other components of the software) (e.g., col.2:28-31 & 45-48, col.3:48-51, see *Compatibility Data 135, Constraints file 120* FIG.1 & associated text, see FIG.5,6 & associated text,) and the software is optimized by updating the software by further referring to the apparatus function information and compatibility information (e.g., col.1:7-15). It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to incorporate the teaching of *Sanders* into that of *Van Ryzin* to include the apparatus function information and compatibility information within the system update module with reasonable success. And the motivation for doing so would have been the inclusion of apparatus function information and compatibility information in the system update module, which is transmitted amongst network apparatuses, eliminates the need for manual analysis of each apparatus (by researching in data books, specification sheets from each apparatus's vendor to determine the apparatus hardware/software function/compatibility information) and manual editing of compatibility information prior to each transmission of the system update module to a different network apparatus by a different vendor.

As per claims 7, 16, and 23, they recite limitations which have been addressed in claim 5, therefore, are rejected for the same reasons as cited in claim 5.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Van Ryzin* further in view of Shaw (US 6381741), hereinafter, *Shaw*.

As per claim 21, *Van Ryzin* teaches a network apparatus according to claim 20 above. *Van Ryzin* does not expressly disclose the system update module containing authentication data and the optimum update data is authenticated by using the corresponding authentication data, and whether update is performed or not is determined by authentication results. However, *Shaw* discloses a network apparatus (e.g., see 10 FIG.1 & associated text) in connection (e.g., see 50



FIG.1 & associated text) with other network apparatuses (e.g., col.1:20-24, col.3:15-19) obtaining system update module (e.g., see *updater 70* FIG.1 & associated text, see 150 FIG.2 & associated text) containing authentication data (e.g., col.2:5-10, see 226 FIG.3 & associated text) and optimum update data (e.g., col.1:38-43, see *updater 70* FIG.1 & associated text) which is authenticated by using the corresponding authentication data, and whether update is performed or not is determined by authentication results (e.g., see FIG.3 & associated text, col.4:19-33 & 37-39, col.5:34-38). It would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to incorporate the teaching of *Shaw* into that of *Van Ryzin* to include the corresponding authentication data in the system update module with reasonable success. And the motivation for doing so would have been that the corresponding authentication data which is included in the received system update module enables the receiving apparatus to authenticate and confirm the trustworthiness of the system update module by comparing the received authentication data with reliable digital certificates known by the receiving apparatus for secure software downloading and upgrading.

### **Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:
- Compiler and method for automatically building version compatible object applications, Carter et al. (US 6519767)
  - Validating an installation plan containing multiple transports and redirectors by adding data structure of the modules to the plan if the indicated transport and redirector modules are unavailable, Shrader et al. (US 5793982)
  - Program compatibility recognition for a programmable logic device, Sung (US 5892683)
  - Methods and systems for booting a computer in a distributed computing system, David et al. (US 5948101)
  - Method and apparatus for enabling access to computer system resources, Williams et al. (US 6094702)


Art Unit: 2122

- System and method for managing computer upgrade in online computer shopping mall, HAN (KR 2001000362)
- Remote maintenance method and remote maintenance apparatus, Maeda et al. (US 6263497)
- Multi-user flash ROM update Bi et al. (US 6279153)
- Intermediate server having control program for storing content accessed during browsing sessions and playback program for asynchronously replaying browsing sessions, Delph (US 6356934)
- Software package management, Forbes et al. (US 6381742)
- Software implementation installer mechanism Delo et al. (US 6418554)

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chrystine Pham whose telephone number is 703.605.1219. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on 703.305.4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**

Chrystine Pham  
Examiner  
GAU 2122  
August 25, 2004